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REMARKS

Claims 13, 17, 19, 22, 23, 26, 27, 28, 32 and 35 have been amended. Claims 1-36, as amended, remain in the application. No new matter is added by these amendments.

In the Office Action dated February 18, 2004, the Examiner rejected Claim 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that Claim 17 recites the limitation "said behavior data" in claim 15 and there is insufficient antecedent basis for this limitation in the claim.

Applicants amended Claim 17 to depend from Claim 16 to correct a typographical error. Claim 16 provides the antecedent basis for "said behavior data".

The Examiner rejected Claims 1-2, 7-8, 13-14, and 16-36 under 35 U.S.C. § 103(a) as being "anticipated" by the U.S. Patent No. 5,122,952 issued to Minkus. The Examiner rejected Claims 3-6, 9-12, and 15 under 35 U.S.C. § 103 as being unpatentable over Minkus.

Based upon the Examiner's comments regarding the reasons for the rejections, Applicants assume that the Examiner meant that Claims 1-2, 7-8, 13-14, and 16-36 are "unpatentable over Minkus".

Applicants amended Claims 13, 22, 23, 28 and 32 to include unintentionally omitted "advice" as one of the items to be matched with the personality type of the individual. Support for this amendment is found on page 10, lines 1-6, of the specification. Claims 13, 22, 23 and 32 are amended to delete "personality based" since it is not the product, advice or service but the matching that is personality based. Applicants amended Claims 26, 27, 28 and 35 to clarify that the administrator is an on-line administrator that selects tests and questions to be presented to the user.

The Minkus Patent

The Minkus patent describes a method of selecting and matching learning tools that possess developmental value with the individual characteristics of a child. Commercially available products consisting of toys, games, books, and allied learning materials are analyzed and the data relating to the personal traits required to use the product, educational value of the product, learning value of the product, instructional variables required to use the product, and the description of the product is entered into and stored in a computer system. Information

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concerning a child's sensory learning style preferences, hobbies and interests, academic conditions, medical conditions, social habits, emotional attitudes, and nutritional habits is entered into the computer system. The system compiles the child data into a report. The system also matches the child data with the product data and a list of preferred products is produced from which parents select appropriate learning tools for the child.

A questionnaire is filled out and reviewed concerning a user (i.e., child) and the data from the questionnaire is entered into the system. The data is matched against the product data and a Preferred Products List of products matched to the unique characteristics of the individual user is produced. From this Preferred Products List appropriate learning tools are selected. Parent(s)/guardian(s)/educator(s) are given a two part questionnaire concerning the child to be answered by themselves or, if the child is old enough, by the child under the parents' supervision. The questionnaires are received, analyzed, and entered into the computer system. Static personal information of the child is merged into a Vital Information Profile (VIP) data file, and preferences, developmental, and skill level information of the child is merged into a Preference Survey Model (PSM) data file. The VIP data and the PSM data for an individual child can be viewed on a monitor or can be printed.

Fig. 1 illustrates a digital computer 2 connected to a keyboard 3 and a monitor 4 for entering the data and displaying the vendor listing, the inventory listing, product matrix listings, user listings, and PSM listings. A printer 6 is provided for printing out a vendor listing, an inventory listing, product matrix listings, user listings, PSM listings, a User Preference Analysis, and Preferred Products lists. At least one mass data storage device 8 (e.g., hard disk) provides storage for a Vendor data file, a Product data file, a Vital Information Profile data file, and a Preference Survey Model data file. One example of a suitable computer system 5 is a Macintosh Personal Computer marketed by Apple Computer Co. of Cupertino, Calif. It is stated that the keyboard and the monitor may be at locations remote from the digital computer and the mass data storage device, such as on the showroom floor of a toy store or in the parents' homes, schools, day care centers, businesses, and on or off-site processing centers.

The Rejections

As per independent **Claims 1 and 7**, the Examiner stated that the Minkus patent discloses a method (system) for determining certain personal characteristics and preferences of an

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individual (abstract), comprising the steps of: subjecting the individual to one or more application specific tests (Table E2, Table E3) and recording the results in a database; subjecting the individual to one or more situational action response tests (Table E3) and recording the results in a database; scoring the results of said tests and classifying the test results based upon a predetermined set of rules and storing the classified results in said database (Table F); and comparing said classified results to a predetermined set of references (product data file) to develop a set of data representing preferences and other characteristics of the individual (Abstract, C37 L30-68, C38 L30-68, Tables E-J).

The Examiner admitted that the Minkus patent fails to expressly disclose subjecting the individual to one or more personality tests. However, the Examiner stated that Minkus does disclose providing the user with tests and recording the results in a database, and official notice is given that personality tests were well known at the time the invention was made (Keirsey Temperament Sorter). According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included subjecting the individual to one or more personality tests, in the system disclosed by Minkus, for the advantage of providing a method of a method (system) for determining certain personal characteristics and preferences of an individual, with the ability to increase the effectiveness of the system by supplying the user with a multitude of different test types.

The Minkus patent does not describe "scoring the results of said tests and classifying the test results based upon a predetermined set of rules and storing the classified results in said database (Table F)" as stated by the Examiner. As explained in column 37 of the Minkus patent, the User Preference Analysis list summarizes the answers from the VIP and PSM and reports the current skill levels of the development and behavioral characteristics of the child in the categories listed in Table F.

In the Minkus patent, an individual has the opportunity to fill out a questionnaire, which is designed to collect information on learning deficiencies. After submitting the results, the user is presented with summary scores. No higher level classification of the test results occurs that corresponds to the "classifying the test results" of Applicants' Claims 1 and 7. The system merely derives a total score by section for the user. There is also no mention in the patent indicating that there is storing of classifications in a database. Furthermore, without the

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classification, there can be no <u>comparing of classification</u> of the results to a predetermined set of references to determine a user's preferences and characteristics as defined by Applicants' Claims 1-12.

The Minkus system does not determine the personal <u>characteristics of an individual</u>. It merely records certain personal characteristics. The Minkus system is not collecting data in order to <u>determine a personality type or trait classification</u>. It simply gathers the personal data that has already been determined, then sorts the data into the predefined categories listed in Table F. This "numerical summary" is not the same as using a predetermined set of rules to determine and select a personality type or similar categorization of the user using the collected data. Applicants' classification step constitutes the creation of new data that the system can then use in subsequent steps.

No "testing" is occurring in the Minkus system. Although the items listed in tables E2 and E3 are taken as inputs into the system, they represent the opinions of the person filling out the questionnaire. The Minkus system is not measuring or detecting personal characteristics. The Minkus questionnaire <u>merely collects data</u> and the system relies completely on the accuracy of the inputs.

As per **Claims 2 and 8**, the Examiner stated that the Minkus patent discloses the step of: using said set of data to provide <u>compatible content, advice or personal introductions to said individual.</u>

As an initial observation, Applicants note that the Examiner failed to identify any support for his statement that Minkus discloses this step. This is the case with most of the following rejections which has forced Applicants to identify portions of the Minkus patent that they believe may be the bases for the Examiner's comments. If the Examiner disagrees with any of Applicants' responses to the rejections, Applicants request that the Examiner identify those portions of the Minkus patent that support the rejections.

In Claims 2 and 8, the term "content" means things like stories, articles, web page elements, colors, page layout, etc. There is no mention in the Minkus patent that different "content" is provided based upon the personality classifications. Minkus also does not suggest using the data collected to provide advice to users, or to match compatible people. Minkus collects data to <u>match compatible toys and games to</u> users based on a learning preference.

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As per independent **Claim 13**, The Examiner stated that the Minkus patent discloses a method for determining characteristic type to facilitate the delivery of characteristic based products or services comprising the steps of a. providing access for individual users to a typing system (Table E2, Table E3); b. identifying a user accessing the system and storing user related identification data (VIP) in a system database (Table D, C37 L30-68); c. collecting data from the identified user including test results and responses to questions and storing the data in the database; d. comparing the test results and the question responses with a predetermined set of references to develop a set of characteristic data of the identified user and determining a characteristic type of the identified user from the characteristic data; and e. matching the characteristic type of the identified user with a corresponding characteristic based product or service (Abstract, 07 L30-68, C38 L30-68, Tables E-J).

The Examiner admitted that the Minkus patent fails to expressly disclose wherein the characteristic type is personality type. The Examiner stated that Minkus does disclose providing the user with a characteristic typing tests and recording the results in a database, and official notice is given that personality tests and personality typing were well known at the time the invention was made (Keirsey Temperament Sorter). Therefore, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included disclose wherein the characteristic type is personality type, in the system disclosed by Minkus, for the advantage of providing a method of a method (system) for determining certain personal characteristics and preferences of an individual, with the ability to increase the effectiveness of the system by supplying the user with a multitude of different tests/characteristic typing formats.

The Minkus patent does not provide access to a personality typing system. A typing system requires additional processing of the collected data. In other words, a typing system analyzes the collected data into higher-level classifications within a classification scheme. Such is the case in a personality test where the raw information is collected; then the answers are processed and the user is placed into a category. The Minkus system merely collects data, summarizes it and performs a matching step.

Skill level
1) place into
category

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The Minkus system does not require identification of the user prior to entry of user data or for later use. The data is referenced to a user number, but anyone knowing the user number can access the data.

The Minkus patent does not develop a set of characteristic data by comparing test results and question responses with a predetermined set of references as claimed. For example, as explained in Applicants' specification if the data collection includes behavioral data, Applicants' system can detect certain answer patterns and make a determination that a specific type of data exists (a trait or characteristic) in the "scoring" step. This determination is then used with all of the other data collected to perform the "matching" step. This classification constitutes the determination and creation of additional data that was not provided directly by the user or a third party but was created by the system and then used in the "matching" step. This does not occur in the Minkus system. The Minkus system merely collects the user's reported data and provides for a simple summary. The Minkus system processes data into a PNR code (Table G3), but these are merely variables representing data that already is provided to the system by a user. The Minkus system does not process data to create new higher-level categorical data.

A fundamental and key premise to the Minkus product/user matching algorithm is to gather data on cognitive abilities and developmental strengths and weakness in the area of learning. Once the Minkus system identifies the learning skill (both strong and weak), it identifies learning tools that can enhance and strengthen or further develop a weakness. The primary desired outcome of the Minkus system is to assist parents in finding learning tools to help develop their child's learning skills.

It is generally understood by the psychological industry that personality tests are not designed nor are they capable of measuring a person's cognitive abilities and skill. They are not designed nor capable of measuring the developmental strengths and weakness of a person. The use of personality tests to perform the product matching that Minkus has described would not be possible. Therefore it would not have been obvious nor anticipated for Minkus to have incorporated personality tests into the described learning tools matching system.

The type of product, service and advice matching defined by Applicants' claims is based upon preferences; not skills. The idea is that people with similar personality types, have similar

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interests and preferences for the same products, services and advice. This type of matching uses a personality test and any data that would assist in predicting preferences in the user.

As per **Claim 14**, the Examiner stated that the Minkus system discloses wherein said step a. is performed remote access to the individual users.

The Minkus patent does not describe "remote access". Minkus refers to a location of the monitor or keyboard that may be in a separate location "remote" from the computer and the data storage devices. This merely indicates that the components of a single system can be physically separated. The user is directly accessing the Minkus system. The Minkus patent does not suggest "remote access" to the computer system, such as over the Internet, where multiple users at remote computers can connect into Applicants' personality typing system simultaneously.

As per **Claim 16**, the Examiner stated that the Minkus patent discloses wherein said step c. includes collecting at least one of demographic data, psychographic data, quality of life data, life style data, behavior data, and declared preferences data from the identified user to obtain the question responses.

The Minkus patent has no classification step with the user data. While it is true that Minkus is collecting demographic data, life style data and behavior data, it only uses this data in its matching routines. It does not use this data to determine a personality type (perform a classification step).

As per **Claim 17**, as understood by the Examiner, the Examiner stated that the Minkus patent discloses wherein said behavior data includes at least one of provided behavior data and observed behavior data.

The Minkus patent does describe collecting provided behavior data and observed behavior data.

As per **Claim 18**, the Examiner stated that the Minkus patent discloses selecting from a plurality of questions and tests specific ones of the questions and tests to be presented to the identified user during said step c. based upon data previously collected from the identified user.

The Minkus patent provides one set of questionnaires. There is no indication that the system determines which questions or tests to present to a user based upon his or her objectives or by analyzing the user profile data. The claimed method dynamically determines the questions

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to be presented to a user based upon certain criteria such as objectives, context for testing and previously answered questions.

As per **Claim 19**, the Examiner stated that the Minkus patent discloses selecting a presentation medium for each of the questions and tests to be presented to the identified user.

Applicants amended Claim 19 to clarify that the selection of the presentation medium occurs after the user has accessed the system. Minkus preselected a presentation medium, before the first use, that is the same for all users.

As per **Claim 20**, the Examiner stated that the Minkus patent discloses performing said step d. by selecting one of a plurality of classification systems based upon a type of matching to be performed in said step e., each said classification system having an associated predetermined set of references.

The Minkus patent refers to sorting all gathered information into a single list of categories as exhibited in Table F. This classification scheme is static and the only one anticipated by Minkus to group the data. This step is a "scoring" step as it merely summarizes the number of answers in each group, but is not a "processing" step. The difference is that Minkus simply 'summarizes' the data but fails to assign higher level categories once the scoring is performed.

In contrast, Applicants' system "scores" the data in "comparing" portion of step d., and then "processes" the data in a "determining" portion of the step that identifies/categorizes an individual into a higher level classification. This builds on the comparing by providing for a process by which the system dynamically chooses one or more classification schemes to 'process' the collected data in order to determine higher level classifications. Each classification system that the claimed method can chose from has an associated predetermined set of references meaning that each classification system has its own scoring or system of rules that will determine how a set of data will be classified within the classification scheme.

As per **Claim 21**, the Examiner stated that the Minkus patent discloses performing said step d. by selecting one of a plurality of scoring methods for scoring the results of the tests.

The Minkus system provides only one scoring algorithm. There is no attempt by Minkus to first determine the user's goals and objectives, so that the scoring could be adjusted, meaning that with the questionnaire, the identical answer data set would yield the identical result each time. Applicants' method could yield different results using the exact same collected data since

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a different set of scoring rules could be selected. There is also no mention in or reason to believe that Minkus anticipates using alternative scoring algorithms to score the same set of data and the same instrument.

As per **Claim 22**, the Examiner stated that the Minkus patent discloses performing said step e. by matching the identified user with the personality based product or service preferred by other users having a similar personality type.

In the Minkus patent, matching is not occurring based on the feedback or preference of others with the same or similar classifications.

Minkus gathers self declared behavioral and performance based questions via a questionnaire. Then it matches toys and games (learning tools) based on a perceived developmental weakness in the child and based on the areas of interest for that child. The toys and games that are suggested are designed to help further develop those areas of weakness. The Minkus matching rules are based on learning developmental needs not preferences and Applicants' claimed method is based on both preferences and needs. Since Minkus is essentially trying to alter the skills and abilities of the user, this limits the type of data that would be useful to perform a match in the Minkus system. This is an important distinction, since the preferences of the different personality types (and their subsequent matching results) could differ even if they all have the same needs. Similarly, those with different learning skills and abilities may receive the same product, service and advice after the matching is performed on personality type.

In the Minkus patent, there is no system determination or verification of the behavior data collected from the user. Since no higher-level classification step is occurring as part of or after the scoring step, no determination of personality could be made or anticipated by the Minkus system. Therefore, it would not be obvious for Minkus to include personality, which requires scoring and a system of categorization of scores. Applicants' method does provide for a. classification step in order to determine and/or verify the data collected from the user.

As per **Claim 23**, The Examiner stated that the Minkus patent discloses performing said step e. by obtaining context data from the identified user and matching the identified user with the personality based product or service associates with the identified user personality type and context data.

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Claim 23 refers to the ability to alter the delivery of products, services, and content based on an additional factor for the <u>context of the advice</u>. In other words, if the goal or objective of the user is to find a new career, Applicants' method would alter its matching algorithms to provide appropriate 'career related' content. A user looking for a career immediately out of school would be provided different products, services and/or content than the user making a career change. The context for the advice is considered. The Minkus system does not collect context data.

As per **Claims 24 and 25**, the Examiner stated that the Minkus patent discloses advising the identified user of the determined characteristic type (Abstract, C37 L30-68, C38 L30-68, Tables E-J). The Examiner admitted that Minkus fails to expressly disclose obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses. However, according to the Examiner, Minkus does disclose providing the user with a report, which is review for errors and omissions (C2 L15-33, C38 L37-45), and Minkus also discloses wherein the user data can be updated (Claim 3 and Claim 5). Therefore, the Examiner believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses, as disclosed by Minkus, for the advantage of providing a method of providing personality based products/services, with the ability to continually update the products/or services based on changing customer needs/opinions.

The review step described (C2 L23-33) refers to a "User Preference Analysis" report. This report is a "list summary" of the results from answering the VIP and PSM questionnaires in the previous steps. Minkus discusses that such a report can be viewed on a computer monitor or can be printed. Minkus also discusses how a technician can review the User Preference Analysis list. Since the User Preference Analysis summarizes the data collected from the questionnaires, the purpose of reviewing this report is to find errors and omissions and then to correct them. This verification step is ensuring the data is input into the system accurately. This process is different than Applicants' claimed interactive process of asking the user to provide feedback on

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whether the personality classification and/or description is correct and then altering it and the scoring algorithm based upon such feedback.

The review step (C38 L37-45) discusses the User Preference Analysis again but also mentions that a "User Preference Profile" is generated based upon the data collected in the "User Preference Analysis." Minkus goes on to say that the report is a written report prepared by a technical professional analyzing the User Preference Analysis data. The report can then be reviewed by parents to aid in selection of learning tools.

The Minkus patent discusses a "technical professional" as the source for the interpretation of the input data while Applicants' method uses algorithms and database derived information as the source for generating the interpretation reports of the data. Again, the Minkus process is different than interactive process (Claim 24) of asking the user to provide feedback on whether the personality classification and/or description is correct and then altering it and the scoring algorithm based upon such feedback.

The review step (C2 L15-23) refers to a "Preferred Products List" that can be reviewed by the parent to evaluate the usefulness invention to match the child profile with the product profiles. This 'usefulness evaluation' is intended to be a check in the process of ultimately getting the best learning tools for the child, but does not constitute a step that will feedback into the system and allow the system to alter a given classification, nor does Minkus describe a process by which the system will alter its scoring algorithms to improve accuracy.

Minkus describes no such feedback loop nor do the flow diagrams show any means by which the system would incorporate any parental/user feedback as part of any effort to improve the accuracy of a scoring algorithm or a classification scheme. The 'review steps' discussed by Minkus are intended to correct errors and omissions from the data input, for a 'technician' to write a report, and to provide for a parental review of the invention's suggesting product list. Having a feedback loop would not have been obvious.

As per **Claim 26**, the Examiner stated that the Minkus patent discloses providing access to the system for an administrator, collecting information from the administrator, selecting the tests and questions to be presented to the identified user, performing said step c. with the selected tests and questions, and informing the administrator of the test results and questions responses.

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Applicants amended Claim 26 to clarify that the administrator is a third party administrator. A typical third party administrator is an employer that uses the system according to the present invention wherein the system is operated by the first party to test a potential employee as a second party. Minkus does not contemplate providing access to the system for a third party administrator.

As per **Claim 27**, the Examiner stated the Minkus patent discloses performing said step b. by assigning to the identified user a password selected by the administrator.

There is no suggestion in the Minkus patent of a third party administrator assigning a password to the user.

As per **Claim 28**, the Examiner stated that the Minkus patent discloses permitting the administrator to select the corresponding product or service.

Applicants amended Claim 28 to clarify that the third party administrator has control over the type or category of products, advice and services the system would use to match against. So in the case of career counseling, the administrator could instruct the system to match to career counseling products, services and advice. A marriage counselor could ask the system to match to relationship products, services and advice. A financial advisor could set up the matching system to select from financial products, services and advice. The Minkus system does not provide for administrators with this flexibility to choose.

As per **Claim 29**, the Examiner stated that the Minkus patent discloses performing said step c. by presenting a series of questions to the identified user, at least one of the questions being selected based upon a response of the identifies user to a previous question in the series of questions.

Claim 29 refers to the ability to present test questions in a deterministic fashion. In other words, the second question presented to the user would be determined based upon how the user answered the previous question. The next question after that would likewise be determined based on how the user answered the first question and the second question and so forth.

The Minkus system provides only one method for delivering the questions in the questionnaire. The questions are in a static (unchanging) order and the same questions in the same order are always presented to every user. How the user actually answers a question does

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not change the questions provided to a user.   There is no mention or implication that the questionnaire would ever be presented in a "deterministic" or "path dependent" manner.

As per **Claim 30**, the Examiner stated that the Minkus patent discloses advising the identified user of the determined personality type, obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses (see Claim 24 and 25 rejections), said step d. being performed by selecting one of a plurality of classification systems based upon a type of matching to be performed in said step e., each said classification system having an associated predetermined set of references.

There is no discussion in the Minkus patent that addresses the issues of a <u>dynamic selection process</u> for a classification scheme.   Specifically, the Minkus patent mentions a single classification of data as referenced in Table F.   Applicants' claimed method is able to incorporate the context of the testing and the matching to alter the classification scheme to be used.   This selection process could use the exact same answers to the exact same questions but utilize a completely different set of classifications.   For example there are several personality theories and they all have differing numbers of types that they try to categorize people into.   For example, Keirsey uses 16 types but Ennagram uses 9 types and the Big Five uses 5.   One of them could be better then others given a different context and/or objectives of the user.   Obviously, the categorization schemes that are selected from are not limited to personality type schemes.

The Minkus patent does not mention or anticipate a dynamic process whereby the system will self-select an appropriate scoring algorithm and classification scheme which is appropriate for the context of the testing.   The Minkus system provides for a single static scoring algorithm for the specific goal of matching user profiles with learning tools.   Since the Minkus system only has a single categorical purpose for matching, it would not be obvious for Minkus to have incorporated <u>multiple scoring methods</u> and <u>classification schemes</u> depending on the context for which the testing is occurring.   Minkus fails to discuss a process or steps that would cause the system to change switch the manner in which it scores the raw data collected from user.

As per **Claim 31**, the Examiner stated that the Minkus patent discloses advising the identified user of the determined personality type, obtaining feedback data from the identified user (see Claim 24 and 25 rejections), utilizing the feedback data to change at least one of a

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scoring method for scoring the results of the tests and the personality type, and performing again said step d.

There is no feedback loop process described in the Minkus patent. Although there is mention that a 'technician' or 'parent' can review the information in the system and override the results, these steps are clearly different than having the system ask the user for feedback on whether or not the classification is correct, taking that information and repeating the scoring process and self-altering the scoring algorithm that's used to classify the user.

As per **Claim 32**, the Examiner stated that the Minkus patent discloses advising the identified user of the determined personality type, obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses (see Claim 24 and 25 rejections), and performing said step e. by matching the identified user with the personality based product or service preferred by other users having a similar personality type.

Just as with Claim 31, there is no feedback loop process described in the Minkus patent. Although there is mention that a 'technician' or 'parent' can review the information in the system and override the results, these steps are clearly different than having a self-adaptive system ask the user for feedback on whether or not the classification is relevant and accurate, then taking that information and repeating the scoring process and self-altering the scoring algorithm that is used to classify the user.

As per **Claim 33**, the Examiner stated that the Minkus patent discloses performing said step c. by selecting an order of presentation of questions to the identified user.

The Minkus Patent makes no mention that the order of the questions would ever change. There is no indication, for example that the question order could be randomized. The question order remains static (unchanging) for each user. There is also no mention that the system could determine the order of the questions based upon the data provided by the user.

As per **Claim 34**, the Examiner stated that the Minkus patent discloses performing said steps a. through e. for a plurality of the individual users associated as a group.

The Minkus patent offers a single set of questionnaires that are designed to test individuals with the goal of matching a single user profile with learning tools. There is no mention that the results, classifications, or content could be aggregated as a group and delivered

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to a group. There is no capability mentioned in the Minkus patent that would allow the system to recognize or aggregate group information so that such group advice could be provided.

The goals and objectives of the Minkus patent are to test and match products for individuals. It is not clear how the collection of group data would further meet the goals of helping the individuals find learning tools. It is the goal of the Minkus patent to help individuals and would therefore not be obvious to interpret the results of a group. In the present invention, the typical user is a third party administrator that may engage in a team building exercise that requires an interpretation of each team member and the team as a whole. The results obtained by testing in groups could not be obtained by testing single individuals as is done by the Minkus system.

As per **Claim 35**, the Examiner stated that the Minkus patent discloses providing access to the system for an administrator, collecting information from the administrator, selecting the tests and questions to be presented to the identified users of the group, performing said step c. with the selected tests and questions, and informing the administrator of the test results and questions responses associated with the group.

The Minkus patent makes no mention of functionality and/or content for groups or based on a grouping of data sets. The Minkus patent describes a process that is designed for a single user to be matched to learning tools. There is no mention for the possibility of such a feature for groups nor is there any reason to believe that it could be made available since the steps involved would need to be quite different than what is mentioned in the patent for individuals users. There is also no mention that an administrator could set up group testing and have access to the groups' results.

As stated above in connection with Claim 34, in the present invention, the typical user is a third party administrator that may engage in a team building exercise that requires an interpretation of each team member and the team as a whole. The results obtained by testing in groups could not be obtained by testing single individuals as is done by the Minkus system.

As per **Claim 36**, Minkus discloses wherein said step d. includes scoring the results of the tests.

The Minkus patent could not have used the MBTI or the KTS (personality assessments) to further a main objective of the system, (identify learning deficiencies in children and to

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suggest learning tools to further develop those deficiencies). It is generally understood by the industry that personality assessments are not capable of measuring learning deficiencies in people nor are they able to measure skills and abilities. Therefore it would not have been obvious to include personality assessments in the Minkus patent.

As noted above, the Examiner rejected Claims 3-6, 9-12, and 15 under 35 U.S.C. § 103 as being unpatentable over the Minkus patent.

As per **Claims 3** and **9**, the Examiner stated that the Minkus patent does not expressly show wherein said personality tests include the Keirsey Temperament Sorter. According to the Examiner, however these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The Examiner stated that the customer personal preference indicator would be performed regardless of the type of personality test used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It is the Examiner's opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the Keirsey Temperament Sorter as the personality test, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As explained above, the Minkus patent does not show or suggest using a personality test.

As per **Claims 4** and **10**, the Examiner stated that the Minkus patent does not expressly show wherein said application specific tests are selected from the group consisting of personality tests, demographics tests, on-line and off-line behavioral response tests, psychographic tests, and life style and quality of life tests. According to the Examiner these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The Examiner stated that the customer personal preference indicator would be performed regardless of the type of application specific test used. Thus, according to the Examiner, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It is the Examiner's opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used

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personality tests, demographics tests, on-line and off-line behavioral response tests, psychographic tests, and life style and/or quality of life tests as the application specific tests, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 4 and 10 define a method and apparatus that determine the appropriate test or tests to present to the user based upon the goals and objectives of the individual. After selecting the appropriate instruments, it would then determine the personal characteristics and preferences of the individual. For example, if the individual stated that he/she was looking for investment advice, the invention would search the database of available tests across several categories and display the appropriate one.

A learning style questionnaire might be one of several tests displayed. However, if the user stated that he/she needed career advice, the system would display assessments that would be appropriate for the career advice for which he/she is looking. After that, the system would determine the personal characteristics and preferences of the individual using the data set from all of the combined instruments.

There is no indication that the Minkus system is able to determine the instrument selected and displayed to the user. There is no mention of behavioral response tests (either on-line or off-line). There is no mention of any lifestyle or quality of life test, nor is there any mention of additional personality instruments or demographics test that a dynamic system would be able to choose from. There is simply one set of questionnaires available for the user with a single objective of being matched to learning tools.

As per **Claims 5 and 11**, the Examiner stated that the Minkus patent does not expressly show wherein said predetermined set of references include characteristics selected from the group consisting of personality traits, skills, competencies, attitudes, beliefs, behaviors, psychographic, demographic and resume items. According to the Examiner these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The Examiner stated that the customer personal preference indicator would be performed regardless of the characteristics of the predetermined set of reference used. Thus, according to the Examiner, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ

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401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579,32 USPQ2d 1031 (Fed. Cir. 1994). It is the Examiner's opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used personality tests, demographics tests, on-line and off-line behavioral response tests, psychographic tests, and life style and/or quality of life tests as the characteristics of the predetermined set of references, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The Minkus patent uses a scoring methodology that simply provides the raw score of the questions into sorted categories (Table F). It does not appear to use the raw scores to actually find a classification of personality or preferences of an individual. It merely reports a numerical score. A classification step would require taking additional steps to select one or more classification schemes then to score and compare the answers patterns to a set of rules then make a determination for each classification scheme. The Minkus patent fails make higher-level of classifications of personality type as it merely adds the scoring of "stated" characteristics. Minkus does not describe a method for determining a classification by using small classifications.

As per **Claims 6 and 12**, the Examiner stated that the Minkus patent does not expressly show wherein the format of each said test is selected from the group consisting of text presentation, video presentation, audio presentation, photographic/image presentation, and combinations thereof. However, according to the Examiner, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The Examiner stated that the customer personal preference indicator would be performed regardless of the format of the test used. Thus, it is the Examiner's opinion that this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). The Examiner believes, therefore, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used text presentation, video presentation, audio presentation, photographic/image presentation, and/or combinations thereof as the format of the test presented to the user, because such data does not

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functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Once again, the emphasis needs to be placed on the dynamic decision making aspect of the system rather than the actual content. The dynamic decision making process is the functional differentiator and is not merely descriptive material. There is no indication that the Minkus system would be able to engage in the selection of multiple formats. The present invention is designed to be flexible regarding the format of the instruments presented to the user. In other words, the present invention may determine to use a mixture of text, video (where, for example, a video of a person is shown asking the questions) and audio format questions to test any particular user. The selection of formats could be done for any purpose, but one example would be if a particular format were known to be a better method of testing given a particular objective or application. Another may be that the system already has information on the user and knows that a particular format is preferred. The Minkus system utilizes only a text format which appears to be static and is presented to all test takers.

As per **Claim 15**, the Examiner stated that the Minkus patent does not expressly show wherein said step c. includes administering at least one of a personality test, a scenario-based test and a roll play-based test to the identified user to obtain the test results. According to the Examiner, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The Examiner stated that the customer personal preference indicator would be performed regardless of the type of the test administered. Thus, according to the Examiner, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). The Examiner believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have administered a personality test, a scenario-based test and/or a roll play-based test to the user, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The Minkus system will only work with the manual input of data. The key distinguisher of this claim is that role-playing and scenario based testing allow the system to actually <u>observe</u>

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behavior as an input. The Minkus system asks for the user's 'opinion' to responses to such questions. There is a big difference here. Minkus makes no mention of using scenario or role-playing testing or in observing behavior in any way. There is also no suggestion that the system has the ability to observe behavior since the data inputs are based on simple text questioning outlined in the patent.

The Examiner stated that additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests Applicants review these documents before submitting any amendments. However, no PTO-892 form was attached.

In view of the amendments to the claims and the above arguments, Applicants believe that the claims of record now define patentable subject matter over the art of record. Accordingly, an early Notice of Allowance is respectfully requested.